REMARKS

I. Status of the Claims

In the Final Office Action mailed December 8, 2009, the Examiner: (1) rejects claims 1, 6, and 31 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; and (2) rejects claims 1-3, 6-11, 13-18, 21-26, 28-33, 36-41, and 43-45 under 35 U.S.C. § 103(a), as being unpatentable over *Marshall* (U.S. Patent Application Publication No. 2002/0116266) in view of *Walker et al.* (U.S. Patent No. 6,018,718), and in view of *COSTCO* (Scally, Robert, "The charge of the family-size bridge: Costco to accept AmEx payments," Discount Store News: Aug. 23, 1999).

By this Amendment, Applicant amends claims 1, 3, 7-11, 13, 16, 18, 22, 24-26, 28, 31, 33, 37-41, and 43, and cancels claims 2, 17, and 31 without prejudice or disclaimer. Claims 4, 5, 12, 19, 20, 27, 34, 35, and 42 were previously canceled. Claims 1, 3, 6-11, 13-16, 18, 21-26, 28-30, 32, 33, 36-41, and 43-45 remain pending in this application. By the following remarks, Applicant respectfully traverses the rejections contained in the Office Action.

II. Rejection of Claims 1, 6, and 31 Under 35 U.S.C. § 112, ¶ 1

Applicants respectfully traverse the Examiner's rejection of claims 1, 6, and 31 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The Examiner alleged that the added subject matter in the last amendments "after the enterprise determines that the relationship is advantageous to the enterprise, wherein the plurality of persons are associated with a higher response rate to a soliciting offer presented by the financial institution than persons not related to the

enterprise"-are not supported by the spec. (Final Office Action at p. 2.) Applicants respectfully disagree. Support for those features are found at e.g., para. [042], where the specification states, "a financial institution may offer to provide a benefit to the financial account of a customer if the customer engages in a non-credit behavior benefiting the enterprise," and "the financial institution may associate a lower credit risk with customers who engage in non-credit behavior and may create general good will by the association and relationship between the enterprise and the financial institution," and para. [044], which explains, "[b]y targeting a group of subjects with existing ties with the enterprise, the solicitation may reap a greater percentage of positive responses than if merely the general public was targeted." Nonetheless, the rejection of claims 1, 6, and 31 is moot in view of the amendment of claim 1.

Accordingly, Applicants request that the Examiner withdraws the 35 U.S.C. § 112, first paragraph rejection and allow claims 1, 6, and 31.

III. Rejection of Claims 1-3, 6-11, 13-18, 21-26, 28-33, 36-41, and 43-45 Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-3, 6-11, 13-18, 21-26, 28-33, 36-41, and 43-45 under 35 U.S.C. § 103(a).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in

the art." M.P.E.P. § 2141(III). A *prima facie* case of obviousness has not been established at least because the Examiner does not correctly determine the scope and content of the prior art, or correctly ascertain the differences between the claimed invention and the cited references.

The Examiner has not properly determined the scope and content of the prior art, at least because *Marshall*, *Walker et al.*, and *COSTCO*, taken individually or in any proper combination, fail to disclose or suggest all the elements of amended claim 1. For example, *Marshall*, *Walker*, and *COSTCO* does not teach or suggest "identifying a plurality of persons engaging in non-credit behaviors benefiting an enterprise unrelated to the financial institution; associating a lower credit risk with persons who engage in non-credit behavior benefiting the enterprise," and "detecting a frequency of non-credit behavior of the person, the detected non-credit behavior benefiting the enterprise; when the detected frequency exceeds a predetermined threshold, determining, by the computing system, the reward associated with the financial account for the person based on the detected frequency of non-credit behavior," recited by amended claim 1.

Marshall is directed to "incentive rewards programs for influencing a variety of desirable behaviors." *Marshall* at para. [0006]. The programs are "maintained by a program administrator," such as "a computer system," connected with various "computer systems of program participants." *Marshall* at para. [0033]. The incentive rewards program "reward[s] the time and timing of the occurrence of tasks, activities and other interactions" between the individuals and the participant organizations. *Marshall* at para. [0011]. For example, individuals enrolled in the incentive program "accumulate time points by engaging in activities specified by the programs" at "multiple

participant organizations." *Marshall* at para. [0031]-[0033]. "Such activities may include purchases, store visits, attending in person or remotely sales presentations, providing blood donations, cash or other donations, engaging in volunteer activities, or a range of other activity which may be desired." *Marshall* at para. [0035].

In the Final Office Action, the Examiner continues to interpret *Marshall*'s "program administrator" as corresponding to the claimed "financial institute," the "participant organization" as corresponding to the claimed "enterprise," the "desirable behaviors" and "tasks, activities, and other interactions" as corresponding to the claimed "non-credit activity," and the "time points" as corresponding to the claimed "reward." (Final Office Action at pp. 3-5.) Based on these interpretations, the Examiner further alleges that the claimed "relationship with the enterprise to reward a person," "soliciting ... the plurality of persons involved with the enterprise to associate a financial account with a reward," and "detecting non-credit behavior of the person," are either disclosed by *Marshall* or inherent. (Id.)

Conceding that *Marshall* is silent about a "financial account" and a "financial institute," the Examiner cites *Walker et al.* to allege the teaching of "awarding particularly financial accounts." (Final Office Action at p. 5.) Further, the Examiner acknowledges that *Marshall* and *Walker et al.* do not disclose that "a lower credit risk is associated with persons who engage in non-credit behavior benefiting the enterprise," as recited in claim 1. (Final Office Action at p. 5.) However, to alleviate this deficiency of *Marshall* and *Walker et al.*, the Examiner cites *COSTCO* for and alleges that *COSTCO* "discloses a credit card company awarding account holders a reduction in

annual fees on their credit card account in exchange for account holder maintaining a COSTCO membership, which benefits COSTCO." (Id.)

Applicants respectfully disagree with the Examiner's interpretation of the cited references. First, *COSTCO* does not cure the deficiency of *Marshall* and *Walker* because, contrary to the Final Office Action's contentions, *COSTCO* does not teach that "associating a lower credit risk with persons who engage in non-credit behavior benefiting the enterprise," as recited in claim 1. While *COSTCO* discloses "a co-branded American Express/Costco card ... issued for the price of a Costco membership" that has "a cash rebate program based on all spending done with the cards," the reference does not teach or suggest that "a lower credit risk is associated with persons" who shop at Costco. *COSTCO* at most teaches that "both Costco and American Express cater to higher-income consumers," which is different from lower credit risk consumers. *COSTCO* at p. 3, column 2, lines 5-6. Therefore, in contrast to the Examiner's allegation, *Marshall*, *Walker et al* and *COSTCO*, alone or in any combination, do not teach or suggest at least the "identifying" element as recited in claim 1.

Moreover, *Marshall* does not teach or suggest "when the detected frequency exceeds a predetermined frequency, determining, by the computing system, the reward associated with the financial account for the person based on the detected frequency of non-credit behavior," recited by amended claim 1, nor does *Walker* or *COSTCO* cures this deficiency of *Marshall*. Although *Marshall* appears to disclose frequency of performing the disclosed activities and interactions, it does not disclose that the rewards are determined under the condition that "the detected frequency exceeds a

predetermined frequency," nor does it disclose or suggest that "the reward associated with the financial account for the person [is determined] based on the detected frequency of non-credit behavior," recited by amended claim 1.

In addition, although *Marshall* discloses that "[i]f the program determines that the individual is not an existing enrolled member, the individual is offered the option of enrolling in the program," *Marshall* at para. [0013], it does not teach or suggest "notifying the plurality of persons of the relationship between the financial institute and the enterprise," as recited by amended claim 1. Therefore, *Marshall* also fails to teach or suggest the "soliciting" element as recited in amended claim 1 and neither *Walker* nor *COSTCO*, nor the combination thereof, cures this deficiency of *Marshall*.

Consequently, the cited art fails to support the rejection of claim 1 and the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1. Applicants thereby respectfully request that the rejection of claim 1 be withdrawn and the claim allowed.

Amended independent claims 16 and 31, although of different scope than claim 1, recite similar subject matter. Accordingly, for at least the same reasons set forth above in connection with claim 1, Applicants also respectfully request the withdrawal of the rejection of claims 16 and 31 under 35 U.S.C. § 103(a) and the timely allowance of these claims.

Dependent claims 3, 6-11, 13-15, 18, 21-26, 28-30, 32, 33, 36-41, and 43-45 are also allowable at least for the reasons set forth above in connection with independent

claims 1, 16, and 31, and because they additionally recite features neither taught nor suggested by the prior art of record. Accordingly, Applicants also respectfully request withdrawal of the rejection of dependent claims 3, 6-11, 13-15, 18, 21-26, 28-30, 32, 33, 36-41, and 43-45 under 35 U.S.C. § 103(a) and the timely allowance of these claims.

IV. Conclusion

The preceding remarks are based on the arguments presented in the Final Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Final Office Action. The pending claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding remarks in favor of patentability are advanced without prejudice to other bases of patentability. Furthermore, the Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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